

REMARKS

Claims presented for prosecution in this Application are claims 14-24, claims 1-13 being canceled by the present (and previous) amendments. In view of Applicant's remarks below, Applicant respectfully submits that claims 14-24 are in condition for allowance. Accordingly, Applicant respectfully requests that the present Response be considered and entered, the rejections to the claims be withdrawn, and that the case now be passed to issue.

Drawing Objections

The Examiner has again objected to the drawings for not showing the "plug socket", described on the second to last paragraph on page 3 of the specification. The Examiner has also iterated that this objection concerns the *drawing* itself, and not the specification.

In response, Applicant again respectfully submits that the "plug socket" of claim 1 is shown in Figure 1, as number **104**.

Applicant therefore again respectfully requests withdrawal of the outstanding objection to the drawings, as at least Figure 1 does, in fact, note the plug socket element as numeral 104.

Rejection under 35 U.S.C. § 112, ¶ 2, of Claims 1, 6 and 11

The Examiner rejects claims 1 and 6 and 11 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner alleged that the phrase "having a direct mechanical utility" in the preamble of claim 1 is vague and indefinite.

Without conceding to the validity of the rejection in this regard, Applicant has canceled claims 1, 6 and 11 merely in an attempt to advance prosecution. Moreover, the offending language has not been repeated in newly added claims 14-24.

Applicant therefore respectfully requests withdrawal of the outstanding rejection of claims 1, 6 and 11.

Rejection under 35 U.S.C. § 102(b) of Claims 1 and 6 and 11 over Scott

The Examiner rejects claims 1 and 6-11 under 35 U.S.C. § 102(b) for allegedly being anticipated by Scott et al.

Without conceding to the validity of the rejection in this regard, Applicant has canceled claims 1, 6 and 11 merely in an attempt to advance prosecution.

Applicant therefore respectfully requests withdrawal of the outstanding rejection of claims 1, 6 and 11.

Rejections under 35 U.S.C. § 103(a) of Claims 12 and 13 over Nagashima in light of Scott

The Examiner rejects claims 12 and 13 under 35 U.S.C. § 103(a) for allegedly being obvious over Nagashima in view of Scott et al.

Without conceding to the validity of the rejection in this regard, Applicant has canceled claims 12 and 13 merely in an attempt to advance prosecution.

Applicant therefore respectfully requests withdrawal of the outstanding rejection of claims 12 and 13.

Rejections under 35 U.S.C. § 103(a) of Claims 1, 6 and 11-13 over Nagashima in view of Leininger and further in view of Scott

The Examiner rejects claims 1, 6 and 11-13 under 35 U.S.C. § 103(a) for allegedly being obvious over Nagashima in view of Leininger and further in view of Scott et al.

Without conceding to the validity of the rejection in this regard, Applicant has canceled claims 1, 6 and 11-13 merely in an attempt to advance prosecution.

Applicant therefore respectfully requests withdrawal of the outstanding rejection of claims 1, 6 and 11-13.

Rejection under 35 U.S.C. § 102(b) of Claims 1 and 6 and 11 over Steele

The Examiner rejects claims 1 and 6-11 under 35 U.S.C. § 102(b) for allegedly being anticipated by Steele.

Without conceding to the validity of the rejection in this regard, Applicant has canceled claims 1, 6 and 11 merely in an attempt to advance prosecution.

Applicant therefore respectfully requests withdrawal of the outstanding rejection of claims 1, 6 and 11.

Rejections under 35 U.S.C. § 103(a) of Claims 1, 6 and 11 over Welsch in view of Steele

The Examiner rejects claims 1, 6 and 11 under 35 U.S.C. § 103(a) for allegedly being obvious over Welsch in view of Steele.

Without conceding to the validity of the rejection in this regard, Applicant has canceled claims 1, 6 and 11 merely in an attempt to advance prosecution.

Applicant therefore respectfully requests withdrawal of the outstanding rejection of claims 1, 6 and 11.

General Comments Concerning Newly Proposed Claims 14-24

As newly proposed independent claims 14, 17 and 21 are each directed towards a chain saw having a combustion engine, and an external plug socket formed in the housing of the chain saw for providing power to an external electrical accessory.

Previous Office Actions have centered on the combination of Nagashima in view of Scott, where Nagashima is utilized to teach knowledge of a chain saw, and where Scott is utilized to teach knowledge of having an outlet for providing power to external devices.

Applicant again respectfully submits that a *prima facie* case of obviousness necessary to sustain such a rejection has not been made. Specifically, MPEP 2143 states:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" (emphasis added).

In response, the Examiner has stated that "there is no requirement that a motivation to make the modification be expressly articulated [in the combined references]". Applicant generally agrees. However, as explicitly recited in MPEP 2143 (and as agreed with by the Examiner) the *motivation* for such a combination (if not *expressly* suggested in the references themselves) **must be** in that knowledge which is generally available to one of ordinary skill in the art.

Applicant therefore once again strongly asserts that the present record is complete devoid of any knowledge of any one in the chain saw art that would suggest placing an externally accessible plug socket for powering external electrical accessories on a chain saw, as is explicitly recited in independent claims 1, 17 and 21.

As Applicant and the Examiner appear to be in agreement that Nagashima does not expressly provide the required motivation to equip a chain saw with an external plug socket, the motivation for the combination must therefore be found "*in the knowledge generally available to one of ordinary skill in the art*" (MPEP 2143).

On this point, the Examiner has stated that, "*Scott is relied upon to demonstrate that it is known in the art to supply an electrical outlet in the form of a socket to provide a means to connect the power supplier and the electrical consumer (lights or tools)*" (emphasis added).

Applicant respectfully submits that Scott's teaching in this regard *simply does not speak to* whether it was *known* to those of skill in the art to specifically equip a *chain saw* with an external plug socket for powering external electrical accessories. Thus, even assuming that Scott's teaching is accurately described by the Examiner, Scott's teaching has no bearing on the *specific modification* of Nagashima's chain saw apparatus that is proposed by the Examiner's previously applied combination.

Moreover, Applicant has previously requested that the Examiner provide some evidence that it was "*in the knowledge generally available to one of ordinary skill in the art*" (MPEP 2143) that chain saws could be modified as suggested by the Examiner, given that the only chain saw reference applied by the Examiner (Nagishima) contained absolutely no teaching or suggestion in this regard. And as previously mentioned, the Examiner's statements regarding the teachings of Scott are simply devoid of any talk, reference to or discussion of chain saws in general, or the electrical configuration or capabilities of the same.

Applicant has even respectfully requested that if the Examiner is unable to locate any reference or evidence which indicates that it was "*in the knowledge generally available to one of ordinary skill in the art*" (MPEP 2143) that chain saws could be modified as suggested by the Examiner, that the Examiner at least take Official Notice of the same, so as to provide Applicant with at least some basis for the Examiner's assertions. To date, the Examiner has provided no evidence, either explicit or not, that it was, in fact, "*in the knowledge generally available to one of ordinary skill in the art*" (MPEP 2143) that chain saws could or should be modified to support an externally accessible plug socket

for electrical accessories. Applicant again specifically and respectfully requests that the examiner provide such evidence, or take Official Notice of the same, should the Nagishima/Scott combination again be applied.

Lastly, Applicants respectfully submit that the generalized teachings of Scott cannot, without more support or suggestion, be wholly imparted to Nagishima without indulging in impermissible hindsight.

That is, Scott concerns a generator whose central purpose is to provide power to external electrical devices. In stark contrast, Nagshima's device is a chain saw whose well known central purpose is to cut typically wooden workpieces. Given that chain saws in general, and specifically Nagashima's chain saw, are designed to be portable and light, it goes against such well known attributes to equip a chain saw with anything that makes that chain saw less portable and light.

Still further, while connecting electrical devices to Scott creates no additional concerns (for this is Scott's central, intended purpose), it is *counter-intuitive* to equip a chain saw to power additional, external electrical devices. Indeed, the knowledge of those in the chain saw art reveals a strong reluctance to have anything attached to the chain saw, for both safety and portability concerns. The present invention has therefore realized a heretofore unknown benefit of providing a chain saw with an external plug socket, a benefit which runs counter to the knowledge of those of skill in the chain saw art.

As previously requested, if the Examiner can provide any evidence to contest Applicants' belief that there is no "*knowledge generally available to one of ordinary skill in the art*" (MPEP 2143) that chain saws could or should be modified to support an externally accessible plug socket for electrical accessories, then Applicants respectfully request that the Examiner make the same of record in the present case.

Absent any additional reference or evidence to indicate that a modification of the nature asserted by the Examiner is within *the knowledge generally available to one of ordinary skill in the art*", Applicants respectfully request allowance of newly proposed claims 14-24.

Of course, should the Examiner believe that there remains any outstanding issues, Applicants respectfully request that the Examiner contact Applicants' Representative so as to expedite resolution of these outstanding issues, via Examiner's Amendment or the like, without the necessity of another Office Action. In particular, should the Examiner believe that claim amendments are necessary to place the case in condition for allowance, Applicants respectfully request that the Examiner contact Applicants' Representative to accomplish the same.

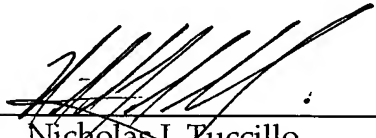
CONCLUSION

In view of the remarks above, it is respectfully submitted that claims 14-24 are allowable, and an early action to that effect is earnestly solicited.

The Examiner is invited to contact the undersigned at the number below to expedite resolution of any issues that the Examiner may consider to remain unresolved. In particular, should a Notice of Allowance not be forthcoming, the Examiner is requested to phone the undersigned for a telephonic interview, an Examiner's amendment, or the like, while the outstanding issues are fresh in the mind of the Examiner.

It is believed that no additional fees or deficiencies in fees are owed. However, authorization is hereby given to charge our Deposit Account No.13-0235 in the event any additional fees are owed.

Respectfully submitted,

By 
Nicholas J. Tuccillo
Registration No. 44,322
Attorney for Applicants

McCORMICK, PAULDING & HUBER LLP
CityPlace II, 185 Asylum Street
Hartford, CT 06103-4102
Tel: (860) 549-5290
Fax: (413) 733-4543